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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,330	05/18/2006	Rune Freyer	2006-IP-019699 U1 USA	1607
49431 7590 01/28/2009 SMITH IP SERVICES, P.C. P.O. Box 997 Rockwall, TX 75087				
EXAMINER ANDREWS, DAVID L				
ART UNIT		PAPER NUMBER		
3672				
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01/28/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,330

Applicant(s)

FREYER, RUNE

Examiner

David Andrews

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed 11/6/2008 has been entered.

Response to Arguments

Applicant's arguments filed 11/6/2008 have been fully considered but they are not persuasive. Applicant argues that the examiner used impermissible hindsight in making the combination of Laflin with the Lembke since one of ordinary skill would have no reason to make the claimed combination. The examiner disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper (In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971)). Lembke teaches that the preferred packer materials for use are those which are a noninflatable type which are actuated by relative movement of packer components in a known manner (col. 2, lines 35+). Laflin teaches that fluid swellable materials can be used to enhance packers of this type (col. 3, line 63 – col. 4, line 15) and teaches that using these materials can benefit such mechanically actuated packers, such as those taught by Lembke, in order to form a better seal. Therefore, one of ordinary skill not does have an explicit motivation in the references to make such a combination, and the

claimed invention rejection under such is deemed obvious in view of the reference teachings.

Applicant also argues that neither of the references teach a slit extending between a through going opening and the outer surface of the packer prior to actuation of the packer. The examiner also disagrees with this assessment of Lembcke, who do describe embodiments which would include this feature (col. 2, lines 52-57).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Lembcke et al. (US 6,173,788). Lembcke et al. disclose a cable duct device comprising: a packer adapted for sealing an annulus; at least one through-going opening provided in the packer and adapted to constitute a duct for a cable or pipe (col. 2, lines 48-57); a slit extending between the through-going opening and an outer surface of the packer prior to actuation of the packer (col. 2, lines 48-57; a longitudinal bore as described must be provided with a slit in order to allow positioning of the cable as taught for groove 14; or alternatively, the split sealing element "longitudinally split" with the cable positioned in the gaps as described would provide the duct and the slit); wherein the packer seals about a cable positioned in the through going opening when the packer is actuated (fig

2); wherein the packer extends lengthwise in a longitudinal direction, wherein the through going opening extends longitudinally through the packer, and wherein a cable extends longitudinally through the opening (figs 1-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lembcke et al. (US 6,173,788) in view of Laflin et al. (US 4,137,970). Lembcke et al. disclose a cable duct device in a swellable packer comprising (and as applied to claim 6 above): a swellable packer (12) of the kind in which the packer is adapted for sealing an annulus; at least one through going opening (col. 2, lines 51-57; see bore or the longitudinal split gap) adapted to constitute a duct for a cable (16); a slit extending between the through-going opening and an outer surface of the packer prior to actuation of the packer (col. 2, lines 51-57; the description of a longitudinal bore instead of a groove or the longitudinally split segments would both provide an opening connected with the outer surface by a slit prior to actuation of the packer); wherein the opening encloses the cable prior to and after the swelling has occurred (col. 2, lines 51-54); wherein the opening may variable longitudinal extension or variable cross-section

(these features are considered obvious over the disclosure of Lembcke since one of ordinary skill in the art being enabled to produce the device of Lembcke would also be enabled to provide the opening as any dimensions a particular application may require). Lembcke et al. also disclose a method of extending a cable longitudinally through a packer comprising: providing a swellable packer including a seal material having an opening extending longitudinally through the seal material, and a longitudinal slit extending between the opening and an external surface of the packer and inserting a cable through the slit (fig 1) and swelling the seal to cause the seal to seal about the cable in the opening (fig 2). Lembcke et al. do not disclose the seal material as swelling and increasing in volume in response to contact with a swell-activating material. Laflin et al. disclose a packer including a seal material which swells and thereby increases in volume in response to contact with a swell-activating material (col. 3, lines 16-19) wherein the swell activating material comprises water (col. 3, lines 56-62). It would have been obvious to one of ordinary skill in the art at the time of invention to replace the seal of Lembcke et al. with the swellable material of Laflin et al. since the Laflin et al. suggest such a substitution (col. 3, lines 63+) and it has been held that the substitution of a known element for another to obtain predictable results is obvious to one of ordinary skill (See MPEP 2141 III).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lembcke et al. (US 6,173,788) in view of Freyer (WO 02/20941). Lembcke et al. disclose a method of extending a cable longitudinally through a packer comprising:

providing a swellable packer including a seal material having an opening extending longitudinally through the seal material, and a longitudinal slit extending between the opening and an external surface of the packer prior to actuation of the packer (col. 2, lines 48-57 describe embodiments which require such) and inserting a cable through the slit (fig 1) and swelling the seal to cause the seal to seal about the cable in the opening (fig 2). Lembcke et al. do not disclose the seal material as swelling and increasing in volume in response to contact with a swell-activating material, wherein the material comprises hydrocarbons. Freyer discloses a packer material which swells by absorption of hydrocarbons to form an annular wellbore seal (abstract). It would have been obvious at the time of invention to substitute the hydrocarbon absorbing packer material of Freyer for the packer material of Lembcke et al. to arrive at the instant invention since the simply substitution of one known element for another to obtain predictable results has been held as obvious to one of ordinary skill (see MPEP 2141, exemplary rationale B).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Andrews whose telephone number is (571)272-6558. The examiner can normally be reached on Monday-Thursday, 7:30am-5pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J. Bagnell/
Supervisory Patent Examiner, Art Unit 3672

DLA
1/21/09